

REMARKS

I. Prosecution History

Claims 1 – 40 stand rejected by the Examiner under 35 U.S.C. §102 and §103. Although several references are cited by the Examiner, the main reference relied upon by Examiner to reject the claims 1-32 and 35-40 under 35 U.S.C. §102 or §103 is US 5,561,446 issued to *Montlick*, and the main reference relied upon by the Examiner to reject claims 33-34 under 35 U.S.C. §102 or §103 is US 6,662,193 issued to *Christensen*.

In response to the Office action, Applicant has cancelled claims 31 and 32, amended claims 1, 8, 10, 22, 25, 27, 30-35, 37 and 40, and has added Claims 41 and 42. Claims 1-32 and 35-42 now remain pending and are presented for further examination.

II. Invention Summary

According to the specification and current claim amendments, Applicants' invention is specifically described in a preferred embodiment to include program/instructions operating operable through a hand held device to enable a user to conduct field assessments for at least one of: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination. Applicants realized that wireless data management devices and wireless communications systems were known in the art when developing their invention, as is also well documented within the "Background" section of their patent application. What is novel about Applicants' invention are the new uses for what at the time of their application filing was new hardware and communications technology with limited data management functions. Wireless

handheld data management devices such as PDAs and data-enabled *wireless* phones having smart capabilities were barely penetrating the handheld market as basic communications and data management devices at the time Applicants filed the present invention. Handheld devices were not publicly described or available with programs and instructions to carry out field assessments in the fields of: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination. This list of program applications are important fields of use that form an integral part of Applicants' invention as now claimed.

With regard to inventory management, Applicants claim methods that enable field technicians to evaluate service calls and reserve inventory required for service calls using a handheld data management device. Applicants' inventory management extends outside of the physical enterprise and enables field technicians to manage inventory needs remotely and wirelessly based on their service schedules. A tie is provided between a technician's service schedule and any inventory management processes that take place using enterprise inventory data systems.

III. Synopsis of primary art cited against Applicants' claims.

Montlick discloses a handheld data management device with features that can probably be found in many publicly available handheld and complimentary enterprise systems. Such a system as described by *Montlick* would be an asset for use to carry out Applicants' inventive features.

Montlick does not teach the use of his handheld data management device, alone or together with a program/instructions operating through a hand held device

to conduct field assessments described in the present patent application: e.g., construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination.

Christensen discloses systems and methods for gathering and updating inventory data within a database through use of hand-held technology. *Christensen's* comprehensive systems and methods can likely be complimented by Applicants' inventory management features as now claimed. *Christensen* does not enable inventory management features for field technicians in the manner than Applicants' claimed invention does. *Christensen* does not teach inventory management features for field technicians based on coordination of service schedules and associated inventory needs.

IV. Requirements for *Prima Facie* Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

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A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*,

721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, *Montlick* or *Christensen* must disclose each element recited respectively therein to the claims for which they apply. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that *Montlick* or *Christensen* fail to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

V. Application of Anticipation Requirements to the rejected claims

The Examiner rejected claims 1, 3, 6, 10, 16, 19 under 35 U.S.C. §102(e) as being anticipated by *Montlick*. Applicants have amended independent claims 1, 8 and 10 to provide clarity and more specificity as to what constitutes their invention. The amendments should provide more clarity to what Applicants claim in light of the rejection, which relies heavily on *Montlick*.

The Examiner argues that *Montlick* discloses a handheld data management device for field assessments. *Montlick*, however, does not specifically describe the field assessment claimed and described by Applicants, field assessment that now form a elemental basis of independent claims 1, 8 and 10.

Applicants' specification and claims together teach a hand held device programmed to enable users (e.g., field assessors) to conduct "field assessments"

that, for purposes of Applicants' invention, include at least one of: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination. *Montlick* does not teach or suggest such assessments.

Applicants have amended independent claims 1, 8 and 10 to provide more clarity as to the scope of their invention. The amendments appear as follows:

Claim 1. A handheld data management device for field assessments, comprising:

a memory for storing field assessment programs and related data;

a microprocessor for executing field assessment programs;

a field assessment program stored within said memory and including at least one template and instructions for a handheld field assessment device user to carry out at least one of: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination;

a user interface adapted for enabling the handheld field assessment device user to interact with said field assessment program; and

synchronization means for providing data to and retrieving data from remote computing resources.

Claim 8. A handheld field assessment device, comprising:

a field assessment program module for providing guidance to user handheld field assessment device user, and for analyzing input data associated with the field assessment, said field assessment program module including instructions for the

handheld field assessment device user to carry out at least one of: construction industry project analysis, HVAC system analysis, project management; equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination;

a positioning module, for providing handheld device location identification;
and

a wireless communication module for providing access to remote data resources to said device.

Claim 10. A method of conducting a field assessment using a handheld data management device, comprising:

providing a hand held data management device user performing as a field assessor access to a industry-specific field assessment program module for enabling the field assessor to execute at least one of the following field assessments: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination;

executing said program module to conduct the field assessment;

providing field-specific information required by said program module for said program module to render data in support of said field assessment; and

retrieving data through said handheld data management device in support of said field assessment.

Applicants believe that claims 1, 8 and 10 overcome the rejection, and therefore the rejection is respectfully traversed. Applicants respectfully request reexamination of the claims rejection as being anticipated by *Montlick* in light of the amended claims and their remarks.

The Examiner rejected claim 33 under U.S.C. §102(e) as being anticipated by *Christensen*. Applicants have amended independent claim 33 to provide clarity and specificity to what constitutes Applicants' invention. The amendment should provide more clarity to what Applicants claim is in light of the rejection, which relies heavily on *Christensen*.

The Examiner argues that *Christensen* discloses a handheld data management device for inventory management. Applicants agree with the Examiner, however, *Christensen* does not specifically describe inventory management using handheld devices as claimed and described by Applicants.

Applicants' specification and claim 33 together teach that "a handheld data management device user prior to the user undertaking a daily field service schedule." Applicant provide in claim 33 that "said handheld management device adapted to conduct in cooperation with the server an assessment of service schedule requirements and available inventory." *Christensen* does not describe these elements.

Applicants have amended independent claim 33 to provide more clarity as to the scope of their invention. The amendment appears as follows:

Claim 33. A method utilizing a handheld data management device for remote inventory management, comprising:

starting an inventory program from a handheld data management device, said program used to ensure that the proper inventory will be provided to the handheld data management device user prior to the user undertaking a daily field service schedule;

enabling the user to identify service schedule requirements;

enabling the user to synchronize the schedule with inventory data stored in a server wirelessly accessible by said handheld data management device;

said handheld management device adapted to conduct in cooperation with the server an assessment of service schedule requirements and available inventory; and providing the user with inventory availability status through the handheld data management device that is based on inventory needs identified in said service schedule.

Applicants believe that claim 33 as amended overcomes the rejection, and therefore the rejection is respectfully traversed. Applicants respectfully request reexamination of the claims rejection as being anticipated by *Christensen* in light of the amended claim and their remarks.

VI. Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

VII. Application of Nonobviousness Requirements to the rejected claims

The Examiner rejected claims 2, 4-5, and 7-8 under 35 U.S.C. §103(a) as being unpatentable over *Montlick* in view of *Alexander* (U.S. Patent No. 6,522,352).

The applicants respectfully assert that the rejection of Claims 2, 4-5, and 7-8 herein fails under the third prong of the obviousness test because, for the reasons discussed *infra*, that *Montlick* neither teaches nor suggests all of the limitations set out in the amended independent claims 1, upon which claims 2, 4-5 and 7 depend, and independent claim 8. In particular, *Montlick* does not teach or suggest a program/instructions operating through a hand held device to conduct field assessments that include: construction industry project analysis, HVAC system analysis, project management, equipment readiness, system and equipment troubleshooting, remote inventory tracking and ordering, conducting legal investigations in the field, and multi-users remote function coordination.

Alexander, Jr. is cited for its teaching a positioning module. Applicants agree that *Alexander* teaches a positioning module, but *Alexander*, alone or in combination with *Montlick*, does not teach Applicants invention as claimed. The rejection fails to satisfy the first prong because, in view of the objectives and teachings of the references, and because there is no motivation or suggestion to combine them to provide field assessment including construction industry project

analysis; HVAC system analysis; project management; equipment readiness; system and equipment troubleshooting; remote inventory tracking and ordering; conducting legal investigations in the field; and multi-users function coordination. In this regard, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. Applicants do not find where a hint or suggestions in *Montlick* or *Alexander* can be found by the skilled to combine either reference to arrive at an invention as claimed by Applicants in claims 1 and 8.

Moreover, 35 U.S.C. §103(a) states that:

[a] patent may not be obtained . . . if the differences between the between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

It is thus improper for the Examiner to formulate the suggestion or motivation to combine prior art references based on current knowledge.

As stated by the Federal Circuit Court in the opinion of *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

The foregoing comprises a caution against piecing together disparate and unrelated disclosures found in the prior art to meet a claimed structure, in the absence of any suggestion in the references implying the desirability of doing so. The applicants respectfully assert that, in view of the aforementioned guideline, combining *Lassiter* and *Strandwitz* is improper and, therefore, a *prima facie* case of obviousness against Claims 6, 7, and 24 cannot be established.

Claim 9, 21 and 31 have been cancelled because their related contents were provided as an element in independent claims 1, 8, 10, 30, 33, 35 and 38. Therefore, the rejection of Claims 9, 21 and 31 will now be discussed.

Claims 9, 21 and 31 were rejected, however, as being unpatentable over *Montlick* in view of *Brick et al.* (U.S. Patent No. 6,172,620). *Brick* is cited by the Examiner as disclosing "a portable data terminal which suggests use of different modules to satisfy application requirements." Applicants have reviewed the portion of *Brick* (col. 1, lines 39-44) in an attempt to find more specific examples of programs executed using the portable data terminal described therein. Nothing more is said other than the portion cited by the Examiner that "different modules" or "applications" can be executed in a handheld device.

Applicants again remind the Examiner of his obligation to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Of the three basic criteria set forth in M.P.E.P. §2143 that a patent examiner must satisfy to establish a *prima facie* case of obviousness, the rejection fails the third element:

the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

Brick does not teach as one of its elements, methods or systems for conducting field assessments including construction industry project analysis; HVAC system analysis; project management; equipment readiness; system and equipment troubleshooting; remote inventory tracking and ordering; conducting legal investigations in the field; and multi-users function coordination.

The applicants respectfully assert that the rejection of claims 2, 4-5, 7, 11-15, 17-18, 20, 22-29, 34, 36-37 and 39-40 to the extent they are now all dependent on independent claims 1, 8, 10, 30, 33, 35 and 38 as now amended, fails under the third prong of the obviousness test because, for the reasons discussed *infra*, *Brick* neither teaches nor suggests all of the limitations set out in the amended independent claims. In particular, *Brick* does not teach or suggest does not teach as one of its elements, methods or systems for conducting field assessments including construction industry project analysis; HVAC system analysis; project management; equipment readiness; system and equipment troubleshooting; remote inventory tracking and ordering; conducting legal investigations in the field; and multi-users function coordination. Therefore the rejection of any of the claims under 35 U.S.C. §103 is respectfully traversed. Applicants respectfully request reconsideration of their claims.

VIII. Conclusion

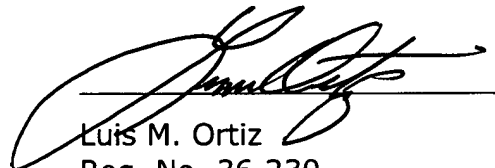
In view of the foregoing discussion, the Applicants have responded to each and every rejection of the Official Action. The Applicants have clarified the structural distinctions of the present invention with its present amendments. Applicant has also added two new claims, 41 and 42, which only serve to further clarify the field of use for their invention.

Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicants' application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: June 21, 2004

A handwritten signature in black ink, appearing to read 'Luis M. Ortiz', is written over a horizontal line.

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